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PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional)
	3713874-00008

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]	Application Number	Filed
	10/773,378	February 6, 2004
on _____	First Named Inventor	
Signature_____	Joseph D. Masci, et al.	
	Art Unit	Examiner
Typed or printed name _____	3714	Thomas Haynes Henry

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☑ attorney or agent of record. 35,602
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

_____
Signature

Adam H. Masia
_____
Typed or printed name

312 807-4284
_____
Telephone number

January 7, 2010
_____
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Joseph D. Masci, et al.
Appl. No.:   10/773,378
Conf. No.:   6343
Filed: February 6, 2004
Title: GAMING DEVICE HAVING A PLURALITY OF PAYLINES AND
               DIFFERENT MODIFIERS ASSOCIATED WITH THE PAYLINES
Art Unit: 3714
Examiner: Thomas Haynes Henry
Docket No.:   3713874-00008 (formerly 114855-008)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

This request is submitted in reply to the Final Office Action dated October 9, 2009, and is filed with form PTO/SB/33, "Pre-Appeal Brief Request for Review," and form PTO/SB/31, "Notice of Appeal." Applicant believes that the interpretations of the claims and prior art in the Final Office Action rise to the level of clear error, making the case proper for pre-appeal review. Please charge Deposit Account No. 02-1818 for the Notice of Appeal fee set forth under 37 C.F.R. §41.20(b)(1) and any other fees due.

I.   CLAIMS 1 TO 66 SATISFY 35 U.S.C. §112, FIRST PARAGRAPH

The Examiner rejected the pending claims under 35 U.S.C. §112, first paragraph, stating that "[t]he claims require the 'predetermined modifier being independent of the winning symbol combination,' however there is no support in the specification that explicitly states that the predetermined modifiers are independent of the winning symbol combinations." (page 2).

The specification discloses modifiers that are independent of any winning symbol combination. Specifically, the specification discloses that "[e]ach of the paylines includes a fixed modifier, such as a fixed multiplier, which multiplies any awards associated with winning symbol combinations." (Abstract) (emphasis added). Thus, the multiplier is static (i.e., it does not change), and is applied identically to any winning

symbol combination generated for a play of the game (i.e., it is applied regardless of which winning symbol combination is generated). The specification also discloses "the paylines are numbered and the fixed modifiers or multipliers are related to the payline number of each of the paylines," (¶11), and "[p]referably, the modifiers or multipliers are fixed such that prior to placing the wager, the player knows what the different modifier is for each of the paylines" (¶13). If the player knows what the different modifier is for each of the paylines prior to placing a wager, the modifiers are independent of any future-generated winning symbol combinations.

The Examiner stated that "[a]s this is essentially a negative limitation (claiming no correlation between the multiplier and the winning paylines), the specification disclosing one way in which the two are not correlated is not enough to say there is no correlation whatsoever." (page 7). The Examiner thus admitted that the specification discloses "one way in which the two are not correlated." To support the claim language, the specification does not need to disclose only embodiments supporting the claim language. Rather, the disclosure of "one way in which the two are not correlated" supports a claim reciting that the two are not correlated – for example, a claim including the language of claim 1 that the predetermined modifier has a value determined independent of each of the plurality of different winning symbol combinations.

Since at least these portions of the specification support the disputed claim language, the rejection of claims 1-66 under 35 U.S.C. §112 is improper.

II.   CLAIMS 1 TO 66 ARE PATENTABLE OVER THE CITED PRIOR ART

A.   *Thomas does not anticipate or render obvious the pending claims*

Thomas discloses a gaming machine that enables a player to activate a number of pay lines according to a number of coins or credits played, (col. 3, ll. 50-54), with winning game outcomes determined according to a paytable. (col. 4, ll. 13-16). An example paytable of Thomas, illustrated at FIG. 3, is reproduced below:

Fig. 3

Symbol	PAY LINE 1	PAY LINE 2	PAY LINE 3	PAY LINE 4	PAY LINE 5
Jackpot Jackpot Jackpot	100	200	300	400	1000
7 7 7	80	80	80	80	80
ANOTHER MIXED 7 7	40	40	40	40	40
(symbol) (symbol) (symbol)	30	30	30	30	30
(symbol) (symbol) (symbol)	20	20	20	20	20
(symbol) (symbol) (symbol)	20	20	20	20	20
(orange) (orange) (orange)	15	15	15	15	15
(watermelon) (watermelon) (watermelon)	10	10	10	10	10
(cherries) (cherries)	5	5	5	5	5
(strawberry) (strawberry)	5	5	5	5	5
(cherry)	2	2	2	2	2
(strawberry)	2	2	2	2	2

In this example, if a winning combination of three Jackpot Symbols is generated, the gaming machine of Thomas provides a number of credits according to the payline on which the winning combination was generated. (col. 6, ll. 17-19). Specifically, if a combination of three Jackpot Symbols is generated, the gaming machine provides 100 credits if that combination is on pay line 1, 200 credits if that combination is on pay line 2, 300 credits if that combination is on pay line 3, 400 credits if that combination is on pay line 4, and 1000 credits if that combination is on pay line 5. For <u>any other winning combination</u>, the gaming device of Thomas provides a same award <u>regardless of the payline on which that winning combination occurs</u>.

The Examiner relied on Thomas' disclosure that awards for combinations of three Jackpot Symbols vary based on the payline on which such a combinations occur as disclosing the claimed predetermined modifiers. The Examiner stated that "Thomas discloses keeping a constant predetermined modifier from game to game." (page 7).

Thomas does <u>not</u> disclose that each of a plurality of predetermined modifiers is associated with a different one of a plurality of paylines and has a value determined independent of each of a plurality of different winning symbol combinations. Assuming, *arguendo*, that the awards of Thomas are calculated by multiplying an amount by a modifier, Thomas does <u>not</u> disclose that <u>each predetermined modifier has a value determined independent of the plurality of different winning symbol combinations</u>. Rather, the modifier of Thomas (to the extent it is properly characterized as such) is <u>only applied for a single winning symbol combination</u> and is thus <u>dependent</u> on an

occurrence of that combination. The language of claim 1, which states that "each of the different predetermined modifiers [has] a value determined independent of each of the plurality of different winning symbol combinations," contradicts the Examiner's position, and demonstrates the impropriety of the Examiner's rejection.

B.   Barrie does not remedy the deficiencies of Thomas

Barrie discloses a gaming device which positions symbols in a playing field, wherein certain symbols persist through two or more sequential rounds of a game. (Abstract). An occurrence of a multiplier symbol in one of the reel positions causes the appearance, or a change in the appearance, of the persistence symbols. (col. 6, ll. 1-5). In the event of such an occurrence, the new value of the persistence symbol is the sum of its previous value and the value of the multiplier symbol. (col. 6, ll. 8-10).

Barrie does not remedy the deficiencies of Thomas. The modifiers of Barrie are dynamic – that is, as multiplier symbols are generated on the reels, the multipliers are added to an already existing persistence symbol. Throughout a play of Barrie, a persistence symbol could have a value of zero, or could have a non-zero value based on multiplier symbols that have been generated during play. Thus, Barrie does not disclose that each of the predetermined modifiers has a value determined independent of the plurality of different winning symbol combinations (the winning symbol combinations of Barrie define the values of the persistence symbols), nor does Barrie disclose that the first predetermined modifier is the same for each play of the game (the value of any of the persistence symbols of Barrie can change throughout the play of the game and/or for different plays of the game).

The Examiner also stated that "the modifiers of [Barrie] are predetermined, even if they can be changed." (page 7). However, the unambiguous language of claim 1 that "the first predetermined modifier is the same for each play of the game" clearly contradicts the Examiner's position.

Claims 2 to 66 each include certain similar elements to claim 1. For reasons similar to those given above, the Examiner's rejection of claims 2 to 66 is improper.

III.   THE FINAL OFFICE ACTION IS IMPROPER

The rejection under 35 U.S.C. §103(a) is improper because the Examiner appears to have only rejected claims 1 to 58, despite the fact that claims 1 to 66 are currently pending.

The rejection under 35 U.S.C. §103(a) is also improper because it does not appear that the Examiner addressed the language of claim 1 that the first predetermined modifier is the same for each play of the game.

As discussed above, the Examiner incorrectly asserted that the claim language that each of the different predetermined modifiers has a value determined independent of each of the plurality of different winning symbol combinations does not satisfy 35 U.S.C. §112, first paragraph. The Examiner's failure to indicate where this element is disclosed in the prior art renders the rejection under 35 U.S.C. §103(a) improper.

Finally, in his rejection of claim 1, the Examiner improperly stated that "Thomas teaches the multiplier being the same for each play of the game," (page 6), without indicating where Thomas discloses this element. The Examiner did not satisfy his burden to present a *prima facie* case of obviousness. Thus, the rejection under 35 U.S.C. §103(a) is improper.

Respectfully submitted,

K&L Gates LLP

BY: _____

Adam H. Masia
Reg. No. 35,602
Customer No. 29159

Dated: January 7, 2009